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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,491	02/28/2002	Noboru Nakashima	0090/004001	6676
22893	7590	07/01/2004	EXAMINER	
			MAIORINO, ROZ	
		ART UNIT		PAPER NUMBER
				3763

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	10/084,491	Applicant(s)	NAKASHIMA, NOBORU
Examiner	Roz Maiorino	Art Unit	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 25 May 2004.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 2-15 is/are pending in the application.
- 4a) Of the above claim(s) 4, 10, 11 and 15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2, 3, 5-9 and 12-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Election/Restrictions***

1. Newly submitted claim 15 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the protective sheath having two slide sheaths.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 15 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 2-3, 5-9 , 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No.6659984 to Maclean Crawford et al.

Maclean Crawford teaches a hollow needle to insert onto a body of a patient; a fixed sheath fixing the hollow needle and having a tubular portion, the tubular portion partially covering the needle; and a protective sheath slidably fitted to and guided by the tubular portion of the fixed sheath; wherein, the protective sheath and the tubular portion of the fixes sheath have a locking means for retracting the sliding movement of the protective sheath relative to the tubular portion and the protective sheath is movable form the tubular portion of the fixes sheath to a position where the tip of the hollow needle is entirely covered. (figures 1-3).

2. Claims 2-3, 5-9 , 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No.6197007 to Thorne et al.

Thorne teaches a hollow needle to insert onto a body of a patient; a fixed sheath fixing the hollow needle and having a tubular portion, the tubular portion partially covering the needle; and a protective sheath slidably fitted to and guided by the

tubular portion of the fixed sheath; wherein, the protective sheath and the tubular portion of the fixes sheath have a locking means for retracting the sliding movement of the protective sheath relative to the tubular portion and the protective sheath is movable form the tubular portion of the fixes sheath to a position where the tip of the hollow needle is entirely covered. (figures 1- 27).

3. Claims 2-3, 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No.5382240 to Lam

Lam teaches a hollow needle to insert onto a body of a patient; a fixed sheath fixing the hollow needle and having a tubular portion, the tubular portion partially covering the needle; and a protective sheath slidably fitted to and guided by the tubular portion of the fixed sheath; wherein, the protective sheath and the tubular portion of the fixes sheath have a locking means for retracting the sliding movement of the protective sheath relative to the tubular portion and the protective sheath is movable form the tubular portion of the fixes sheath to a position where the tip of the hollow needle is entirely covered. (figures 1-8).

4. Claims 2-3, 5-9 , 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No.5498241 to Fabozzi.

Fabozzi teaches a hollow needle to insert onto a body of a patient; a fixed sheath fixing the hollow needle and having a tubular portion, the tubular portion partially covering the needle; and a protective sheath slidably fitted to and guided by the tubular portion of the fixed sheath; wherein, the protective sheath and the tubular portion of the fixes sheath have a locking means for retracting the sliding movement of the protective sheath relative to the tubular portion and the

protective sheath is movable from the tubular portion of the fixes sheath to a position where the tip of the hollow needle is entirely covered.

***Response to Arguments***

5. Applicant's arguments with respect to claims 2-3, 5-9 , 12-14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 703-305-2336. The examiner can normally be reached on 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM



  
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SUPERVISORY PATENT EXAMINER  
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